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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/305,084 05/04/99 SCHNEIDER R 5914-080-999

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NEW YORK NY 10036-2711

EXAMINER

HARRIS, A

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

11/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/305,084

Applicant(s)

Schnelder And Jamal

Examiner
Alana M. Harris, Ph. D.

Group Art Unit
1642



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-13 is/are pending in the application
- Of the above, claim(s) _____ is/are withdrawn from consideration
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-13 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Restriction Election Facsimile Transmission

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, drawn to a method for treating a cancer comprising administering a compound, classified in class 435, subclass 6. Claim 5 will be examined with Group I to the extent that the compound is an antisense molecule.
 - II. Claims 1-5, drawn to a method for treating a cancer comprising administering a compound, classified in class 435, subclass 27. Claim 5 will be examined with Group II to the extent that the compound is a ribozyme molecule.
 - III. Claims 1-4 and 6, drawn to a method for treating a cancer comprising administering an antibody, classified in class 435, subclass 7.1.
 - IV. Claims 7-12, drawn to a pharmaceutical formulation for the treatment of a cancer comprising an antibody, classified in class 424, subclass 140.1. Claim 12 will be examined Group IV to the extent that the pharmaceutical formulation is an antibody.
 - V. Claims 7-11, drawn to a pharmaceutical formulation for the treatment of a cancer comprising an antisense molecule, classified in class 424, subclass 9.1. Claim 11 will be examined Group V to the extent that the pharmaceutical formulation is an antisense molecule.
 - VI. Claims 7-11, drawn to a pharmaceutical formulation for the treatment of a cancer comprising a ribozyme, classified in class 424, subclass 9.34. Claim 11 will be

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examined Group VI to the extent that the pharmaceutical formulation is an ribozyme.

VII. Claim 13, drawn to a method for screening for a potential antagonist comprising administering a test compound to a cell, classified in class 435, subclass 4.

2. The inventions are distinct, each from the other because of the following reasons:

The methods of Groups I-III and VII differ in the method objectives, method steps and parameters and in the reagents used.

Inventions of Groups I-III and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions all utilize different compounds, which possibly have different effects on the treatment of distinct and individual cancers.

3. Groups I-VI are drawn to methods for treating a cancer and a pharmaceutical formulation that consists of five different types of cancer, which differ in organ, tissue and cell types. Each cancer type differs in invasive and metastatic potential. The examination of a method of treating encompassing more than one cancer type would result in an undue search burden on the PTO. Thus, with the election of Groups I-VI, the applicant is required to select one of the five types of cancer consisting of melanoma, prostate cancer, colon cancer, ovarian cancer or mammary cancer.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Attempts to reach Laura A. Coruzzi by telephone on November 17, 2000 to request an oral election to the above restriction requirement were unsuccessful.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

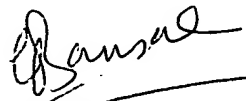
7. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Anthony Caputa, Ph.D., Supervisory Patent Examiner at Anthony.Caputa@uspto.gov or 703-308-3995. Thank you in advance for allowing us to enhance

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our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

8. Papers related to this application may be submitted to Group 1642 by facsimile transmission. Papers should be faxed to Group 1642 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Crystal Mall One Fax Center telephone number is (703) 308-4242 or (703) 305-3014.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris whose telephone number is (703)306-5880. The examiner can normally be reached on Monday through Friday from 6:30 am to 3:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703)308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0196.


GEETHA P. BANSAL
PRIMARY EXAMINER